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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,585	12/20/2006	Laurent Dubedout	291613US6PCT	5553
22850 7590 06/11/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WILLIAMS, ROBERT H.				
ART UNIT 4134		PAPER NUMBER		
NOTIFICATION DATE 06/11/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/580,585

**Applicant(s)**

DUBEDOUT ET AL.

**Examiner**

Robert Williams

**Art Unit**

4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/25/2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 5/25/2006 and 8/9/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.
2. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

4. Claims 6, 11, 12, 13, 15, 16, 17, and 18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent

claim cannot depend from any other multiple dependent claim. Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because it is in dependent form but does not contain a reference to a claim previously set forth. Claims 7, 9, 10, 14, and 19 are objected to under 37 CFR 1.75(c) as being in improper form because they depend from claims in improper form. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

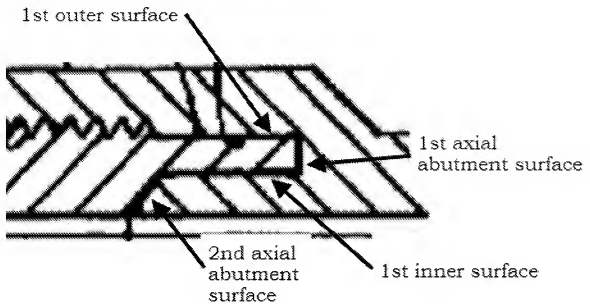
6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by PCT Application Publication WO 98/42947, Metcalfe, hereafter, “Metcalfe ‘947.”

7. Metcalfe ‘947 discloses the claimed invention as follows:

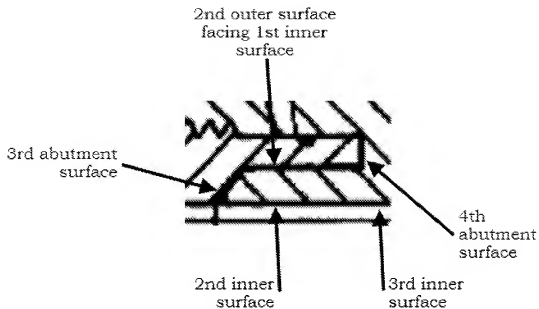
- The claimed assembly of two expandable threaded tubular joints (page 8, lines 11-21, “The assembly ... allows lengths of expandable tubing to be connected to form a string, [and]

comprises a tubular connector ... utilized to join the ends of two lengths of expandable tubing,” Fig. 2, #20, 21, 24, 25);

- The claimed first tubular element arranged at an end of a tube and comprising a first portion, provided with a male thread (page 9, line 3, “threads on the outer surface of the tubing,” Fig. 2 #24, 28);
- The claimed second portion extending said first portion (page 9, lines 3-4, “Inwardly of the threads, the end portions,” Fig. 2 #20, 21);
- The claimed second portion comprising a first outer surface, a first annular lip having a first axial abutment surface and a first inner surface and delimited by said first outer surface over a portion of the axial length thereof, and a second abutment surface (page 9, lines 5-6, “corresponding tongues provided on the ends of the tubing lengths,” Fig. 2 #32, and as shown below);



- The claimed second tubular element comprising a female thread, matching the first male thread and screwed thereto (page 9, lines 1-3, "inner walls of each connector end portion define threads for engaging corresponding threads on the outer surface of the tubing," Fig. 2 #26, 27);
- The claimed second annular lip having a third abutment surface, a second outer surface, capable of being arranged to face said first inner surface, a second inner surface, a third inner surface and a fourth axial abutment surface (Fig. 2, as shown below);



- The claimed annular recess matching and receiving the corresponding first lip (page 9, lines 5-6, “grooves to receive corresponding tongues provided on the ends of the tubing lengths,” Fig. 2 #30, 31);
- The claimed female/female-type connection sleeve (page 8, tubular connector, Fig. 2 #16);
- The claimed central portion (page 8, lines 17-18, “intermediate portion,” Fig. 2 #22);
- The claimed annular zone having an initial reduced thickness (page 8, lines 26-28, “the connector end portions are upset, that is they include portions of greater wall thickness than the tubing and are of a greater diameter than the tubing,” Fig. 2);

- The claimed each second abutment surface rests against the corresponding third abutment surface and/or each abutment surface rests against the corresponding fourth abutment surface (Fig. 2, and as shown above); and
- The assembly of Metcalfe '947 is inherently capable of developing, after diametrical expansion in the plastic deformation region, sealing interference contacts sealing the assembly

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe '947.
10. Regarding Claim 2, Metcalfe '947, as applied to Claim 1 above, discloses the claimed invention except for the claimed zone of reduced thickness in the form of a dish provided with a central portion having said maximum reduced thickness and lateral walls inclined at an angle



of less than approximately 30°. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Please note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations.

11. Regarding Claim 3, Metcalfe '947, as applied to Claim 2 above, discloses the claimed invention except for the claimed said angle equal to approximately 15°. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Please note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations.

12. Regarding Claim 4, Metcalfe '947, as applied to Claims 2 and 3 above, further discloses the claimed dish extends substantially in a zone between last threads of the two female threads, as shown in Figure 2.

13. Regarding Claim 5, Metcalfe '947, as applied to Claim 4 above, further discloses the claimed dish extends substantially between said third abutment surfaces of the two second tubular elements, as shown in Figure 2.

### ***Double Patenting***

14. Claims 1 and 6-19 are provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over the outstanding claims of copending applications No. 10/580,607 and No. 10/580,718. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent application and covered by patented claims. The patented claims are inclusive for they are drafted using the "comprising-style" format and cover the subject matter of the application claims. Since application claims has obtained the right to exclude others from making or using the subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of the application into the patent without a

terminal disclaimer as provided for under 37 CFR section 1.321 (b) would amount to an extension of this right.

15. This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. PCT Application Publication WO 03/060370 A1 discloses an expandable tubular joint with annular lips and an inner annular groove. U.S. Patent 3,870,351 discloses a threaded connection for expandable tubular members with concave and convex axial abutment surfaces. U.S. Patent 4,943,095 discloses a threaded connection for expandable tubular members with an internal annular groove. U.S. Patent 5,419,595 and 5,829,797 each disclose a threaded connection for expandable tubular members with threads including angled flanks and an inner annular groove. U.S. Patents 5,687,999 and 5,769,466 each disclose a threaded connection for expandable tubular members with multiple axial abutment surfaces and an inner annular groove. U.S. Patents 6,478,344 and 6,607,220 each disclose a threaded connection for expandable tubular members with an inner annular groove.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Williams whose telephone number is (571)270-1155. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Fri 7:30-4:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on 571-272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. W./  
Examiner, Art Unit 4134  
/George Nguyen/

Supervisory Patent Examiner, Art Unit 4134